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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,907	06/07/2006	Koji Miyagawa	2006_0871A	9226
52349 7590 03/31/2010 WENDEROTH, LIND & PONACK L.L.P. 1030 15th Street, N.W. Suite 400 East Washington, DC 20005-1503				
EXAMINER				
SHIBRU, HELEN				
ART UNIT		PAPER NUMBER		
2621				
NOTIFICATION DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/581,907

**Applicant(s)**

MIYAGAWA ET AL.

**Examiner**

HELEN SHIBRU

**Art Unit**

2621

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 17-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. The amendments filed on 12/11/2009 have been entered and made of record. Claims 1-11 and 17-19 are pending, claims 12-16 and 20 are cancelled.

***Response to Arguments***

2. Applicant's arguments with respect to claims 1-11 and 17-19 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikuchi (EP 1, 195, 766) in view of Kuroda (US Pat. No. 6, 311, 011).

**Note to the Applicant:** The USPTO considers the Applicant's "or" language to be anticipated by any reference containing one of the subsequent corresponding elements.

Regarding claim 1, Kikuchi teaches a recording apparatus for recording contents, said recording apparatus comprising: a drive unit operable to have a portable recording medium removably attached (see figure 1, unit 1001, and paragraph 0069); a relief recording medium (claim 2 and figure 1, unit 2001); an obtaining unit operable to obtain specification information which specifies one or more portable recording media to be used for recording a content (see paragraphs 0073-0076 and figure 1); a recording control unit operable to perform control so that

(i) in a case where one of the specified portable recording media is attached to said drive unit when the content is to be recorded, the content is recorded onto the attached portable recording medium (see abstract, claim 1 and paragraphs 0057-0059).

Claim 1 differs from Kikuchi in that the claim further requires the recording control unit operable to perform control in a case where none of a specified portable recording media are attached to said drive unit when the content is to be recorded, the content is recorded onto said relief recording medium; and a dubbing control unit operable to, when triggered by a detection that one of the specified portable recording media is attached to said drive unit after the content has been recorded onto the relief recording medium, dub the recorded content from said relief recording medium onto the one of the specified portable recording media.

In the same field of endeavor Kuroda teaches in figure 22 that when DVD and VCR are unavailable, and the HDD is selectable. Kuroda further teaches temporarily recording the video and audio signals on HDD, as shown in figure 3, step 101. Kuroda further teaches when recording device is available, dubbing the video and the audio signal from the HDD to the selected devices (see figures 3-6, 9,22, claim 1 which recites indirect recording means for copying the signals from HDD indirectly and col. 5 lines 9-col. 6 line 29, col. 8 lines 55-67, col. 11 lines 16-42). Therefore in light of the teaching in Kuroda it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikuchi by providing a selecting methods that selects another recording device when one is not available and copying the signal when device is available in order to reserve back up copies of the video and audio signals.

Regarding claim 2, Kikuchi discloses the specification information specifies one portable recording medium, using a piece of identification information which uniquely identifies the one portable recording medium; and said recording control unit judges that the specified portable recording medium is attached to said drive unit when a currently attached portable recording medium is identified with the piece of identification information (see claim 10 and paragraphs 0067-0070).

Regarding claim 3, Kikuchi discloses the specified portable recording medium has the piece of identification information recorded thereon; and said recording control unit makes the judgment by comparing the piece of identification information recorded on a currently attached portable recording medium with the piece of identification information used by the specification information (see paragraphs 0079-0082 and claim 11).

Regarding claim 4, Kikuchi discloses the specification information specifies the one or more portable recording media, using a piece of identification information that identifies a group made up of the one or more portable recording media; and said recording control unit judges that one of the specified portable recording media is attached to said drive unit when a currently attached portable recording medium belongs to the group identified with the piece of identification information (see paragraphs 0079-0083).

Regarding claim 5, Kikuchi teaches each of the one or more specified portable recording media has the piece of identification information recorded thereon, the piece of identification information showing the group to which each recording medium belongs; and said recording control unit makes the judgment by comparing the piece of identification information recorded

on a currently attached portable recording medium with the piece of identification information used by the specification information (see paragraphs 0105-0109).

Regarding claim 6, Kikuchi teaches a list storing unit that stores a list showing the one or more specified portable recording media belonging to the group (see paragraph 0115), wherein said recording control unit makes the judgment by referring to the list (see paragraphs 0096-0117).

Regarding claim 7, Kikuchi teaches obtaining unit is further operable to obtain time information which indicates a time at which the content is broadcasted as a broadcast program, and the said recording control unit performs the control so that the content is recorded at the time indicated by the time information (see paragraphs 0101-0102).

Regarding claim 8, Kikuchi teaches the obtaining unit obtains the specification information and the time information based on a piece of preprogramming information provided by a user who preprograms the recording of the content (see paragraph 0104-0106).

Regarding claims 17-19, the limitations of claims 17-19 can be found in claim 1 above. Therefore claims 17-19 are rejected for the same reasons as discussed in claim 1.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 18, is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In the state of the art, transitory signals are commonplace as a medium for transmitting computer instruction and thus, in the absence of any evidence to the

contrary and give the broadest reasonable interpretation, the scope of a "computer readable medium" covers a signal per se.

***Allowable Subject Matter***

7. Claims 9-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 9, the Prior Art fails to teach or suggest apparatus of claim 1 including the specification information specifies one portable recording medium; a piece of preset information is recorded on the specified portable recording medium, the piece of preset information instructing that the content should be recorded and including the time information; and when the piece of preset information is read from the portable recording medium, the obtaining unit obtains (i) the specification information for instructing that the content should be recorded onto the portable recording medium having the piece of preset information, and (ii) the time information included in the piece of preset information.

Regarding claims 10-11, claims 10-11 are objected as being dependent upon the objected claim.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571)272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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/HELEN SHIBRU/  
Examiner, Art Unit 2621  
March 12, 2010

/Thai Tran/

Supervisory Patent Examiner, Art Unit 2621